

REMARKS

To place the application in *prima facie* condition for allowance, claims 4, 7, 10, 17, 18, 22, and 23 have been canceled; independent claims 1 and 16 have been amended to incorporate the subject matter of claims 4, 7, and 10; independent claim 21 has been amended to include the subject matter of now canceled claims 4 and 7, and new claim 24 has been added and is directed to the subject matter of now canceled claim 10; and dependent claim 5 has been amended for clarity.

Independent claims 1, 16 and 21 have simply eliminated the text added by amendment August 12, 2003. As such, the rejection of claims 1-23 under 35 U.S.C. 112, first paragraph should now be withdrawn.

As discussed at length in previous amendments, the invention is directed to a verification procedure and system for verifying the authenticity of goods. Verification can be performed with a contacting or contactless card reader equipped with appropriate public key or zero-knowledge protocols decrypt identifying information on a tag affixed to or embedded in the goods. Authentication is based solely on the identifying information stored in the tag, and the authentication information stored in the tag is used for authenticating the article without being revealed (see page 5, lines 20 et seq.; and each of the independent claims). The Examiner's attention is directed to the paragraph bridging pages 11 and 12 where it is explained how a public key/private key methodology can be used to verify authenticity of a product based on the routing information (i.e., the product is authenticated when the routing information on the product matches the routing information obtained using a public key). Only the manufacturer can create smart tags with the associated data; therefore, passing off counterfeit goods would be virtually impossible.

The undersigned disagrees with all of the explanations and conclusions advanced by the Examiner in the previous office action for the reasons which have been previously advanced in the case. However, in order to achieve an allowance in an application for which the undersigned believes is long overdue and one where the parent patent (6,069,955) was issued quite some time ago, the

independent claims have been amended to incorporate subject matter not taught in any of U.S. Patent 6,150,921 to Werb, the article to Fuji-Keizai, U.S. Patent 5,740,250 to Mob, U.S. Patent 5,140,634 to Goillou; U.S. Patent 5,367,148 to Storch; U.S. Patent 5,971,435 to DiCesare; U.S. Patent 5,164,988 to Matyas; and U.S. Patent 4,758,714 to Carlson. Therefore, the claimed subject matter cannot be obvious over any combination of the references of record in the case, and the Examiner should now withdraw all rejections lodged under 35 U.S.C. 103, and pass the case to issuance (these rejections being for obviousness of claims 1-3, 5, 6, 8-10, 15, 16, and 18 over a combination of Werb in view of Fuji-Keizai; obviousness of claim 4 over Werb and Fuji-Keizai in view of Mob; obviousness of claims 7 and 17 over Werb and Fuji-Keizai in view of Guillou; obviousness of claim 11 over Werb and Fuji-Keizai over Storch; obviousness of claim 12 over Werb and Fuji-Keizai; obviousness over claims 13 and 20 over Werb and Fuji-Keizai in view of DiCesare; obviousness of claim 19 over Werb and Fuji-Keizai in view of Matyas; obviousness over claim 21 over Werb and Fuji-Keizai in view of Matyas and in further view of DiCesare; and obviousness of claims 22-23 over Werb and Fuji-Kezai in view of Carlson—it being understood that rejections lodged against claims 7, 10, 17, 18, 22 and 23 are moot in view of their cancellation).

All references relied upon by the Examiner, except for Werb, have been discussed extensively in prior responses filed in this case and are not repeated here. The Werb reference is unrelated to counterfeit or parallel market protection; rather, it pertains to tracking mobile tags and determining the position of the mobile tags by measuring round trip signal time.

In short, the present invention defined by independent claims 1 and 16, and dependent claim 24, require both an electronic tag with encrypted information pertaining to an article to which it is affixed or embedded to the article, and a label with printed authentication information that is associated with the article. The authenticity of the article (not the tag) is determined by comparing the decrypted information with the printed information. Thus, if the public key used by the purchaser or at the point of sale cannot decrypt the tag, the article is a counterfeit. Further, if the decrypted information obtained using the public key does not match

up with (it being understood that encrypted information need not be identical to the printed information) the printed information, then article is a counterfeit. With particular respect to claim 21, if the routing information at the point of sale does not match up with the decrypted routing information stored on the electronic tag, then the article is a fake.

Simply put, no reference now of record in the case shows the ability to determine the authenticity of an article using a zero knowledge protocol from information contained in a memory of an electronic tag attached to or embedded in the article. The additional features of the claim further distinguish from the prior art (e.g., use of public key/private key; comparison with a label attached to or printed on the article or carton containing the article; use of routing information, etc.).

While smart tags are “known”, their application in an anti-counterfeiting system and method to determine authenticity of an article is not known (it is also not taught in Fuji-Keizai). Further, while public-key/private-key technology and zero knowledge protocols are “known”, their application in an anti-counterfeiting system and method to determine authenticity of an article is not known.

Moreover, not one piece of prior art contemplates comparing routing information stored in an electronic tag to anything else. Finally, none of the prior art shows comparing decrypted information with printed information, both of which are associated with the article itself for which the determination of authenticity is desired.

Thus, even if all the references are combined (which would be improper due to the lack of motivation to do so), the resulting product would not have or suggest a product which has all of the features now recited independent claims 1 16 and 21.

In view of the foregoing, it is respectfully requested that the application be reconsidered, that claims 1-3, 5, 6, 8, 9, 11, 12, 13, 15, 16, 19, 20, 21, and 24 be allowed, and that the application be passed to issue.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a

telephonic or personal interview.

A provisional petition is hereby made for any extension of time necessary for the continued pendency during the life of this application. Please charge any fees for such provisional petition and any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 50-2041.

Respectfully submitted,



Michael E. Whitham
Reg. No. 32,635

Whitham, Curtis & Christofferson, P.C.
11491 Sunset Hills Road, Suite 340
Reston, VA 20190
Tel. (703) 787-9400
Fax. (703) 787-7557